

REMARKS

The claims have been amended, as set forth above. Accordingly, claims 1-10 and 13-17 remain for consideration in this application.

Claim 3 is objected to, on the basis that the terms “upper” and “lower” are inaccurate for describing the ends of the actuator.

Amended Claim 3, as shown above describes a “head end” and a “bottom end” instead of upper and lower. A “head end” corresponds to a rod head 40A (page 9, line 12 of the Specification), while “bottom end” corresponds with a cylinder bottom 40B (page 9, line 15 of the Specification). While the “upper” and “lower” language is present in the specification, the above changes are provided to clarify the claim.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kiekhaefer (USP 3,084,657).

Kiekhaefer is a newly cited reference. Kiekhaefer discloses a system in which opposing steering cylinders 40, 41 attached to a pivoting engine 5, pivot engine 5 through a predetermined range. Engine 5 pivots within a cowl portion 15 of the cowl structure 14, which structure remains fixed regardless of the position of the engine itself. As the engine pivots, so does lower unit 6 which contains propeller 9. In Kiekhaefer, a drive shaft 8 is rotatably supported within vertical drive shaft housing 4.

On the other hand, the steering system as set forth in amended claim 1 is a totally different type of system. Specifically, claim 1, as amended, requires the following:

A steering system for pivoting an outboard motor mounted on a stern of a boat, said outboard motor having an internal combustion engine

disposed inside of and fixed with respect to an engine cover at its upper portion...

This clarifies the language in the claim so that the internal combustion engine of the outboard motor is “disposed inside of and fixed with respect to an engine cover”. This type of outboard motor is illustrated in the drawings of this application.

On the other hand, Kiekhaefer is a totally different type of outboard motor. As noted above, in Kiekhaefer, engine 5 pivots within a cowl portion 15 of the cowl structure 14, which remains fixed regardless of the position of the engine. This is most clearly illustrated in Fig. 3 of Kiekhaefer. Accordingly, it is clear from the language of amended claim 1, that the internal combustion engine is fixed with regard to the cowl portion and does not pivot inside of it, as in the Kiekhaefer reference. Accordingly, in view of the amendments to claim 1, set forth above, it is submitted that claim 1 clearly distinguishes over the Kiekhaefer reference. Thus, it is respectfully requested that the above rejection be withdrawn, since Kiekhaefer does not disclose each and every limitation set forth in amended claim 1.

Claims 1-3 are rejected under 35 U.S.C. 130(a) as being unpatentable over Japan ‘495 in view of Fujimoto (USP 5,190,488) and Ferguson.

Fujimoto is a newly cited reference. It is a position of the office action that it would be obvious to employ the steering cylinders of Japan ‘495 and Ferguson on an outboard motor as taught by Fujimoto.

In Fujimoto, as best seen Figs 1-2, simply the rear portion of the outboard motor of Fujimoto pivots. However, Fujimoto does not have a swivel case and swivel shaft which pivots or rotates with respect to one another. More specifically, in Fujimoto, a dive shaft housing 43,

which is continuous with the lower unit 45, pivots about universal joint 77. It pivots on steering shaft 35.

As noted above, claim 1 requires

A steering system for providing an outboard motor mounted on a stern of a boat, said outboard motor having an internal combustion engine disposed inside of and fixed with respect to an engine cover at its upper portion and a propeller with a rudder at its lower portion powered by the engine to propel and steer the boat,...

Thus, as set forth above, amended claim 1 requires a steering system for “pivoting an outboard motor” and having a cover fixed to the outboard motor. When the outboard motor is pivoted, then the engine must also be pivoted. Clearly, Fujimoto does not disclose this feature, because the engine remains fixed while the rear portion of the outboard motor pivots. Accordingly, Fujimoto is a completely different system than the claimed invention. As noted above, this difference is clearly set forth in claim 1.

It is the position of the Office Action that in view of Japan ‘495 and Ferguson, it would have been obvious to one of ordinary skill in the art to employ the steering cylinder of Japan ‘495 on an outboard motor as taught by Fujimoto. It is respectfully submitted that Fujimoto is not properly combined with Japan ‘495 and Ferguson to disclose, or suggest, the invention of amended claim 1. Japan ‘495 and Ferguson are directed to normal outboard motors. Fujimoto discloses an unusual type of outboard motor in which the engine is fixed, and the rear portion pivots by way of a U-joint. It is respectfully submitted that one of ordinary skill would not be motivated to combine an outboard motor having two halves which are pivoted with respect to one another with either Japan ‘495 or Ferguson.

Accordingly, in view of the amendments to claim 1, and the remarks set forth above, Applicants submit that claim 1 is not obvious over Japan '495 in view of Fujimoto and Ferguson. Furthermore, since claims 2 and 3 are dependent from claim 1 and limited to the features set forth therein, claims 2 and 3 also are not obvious over the above references. Accordingly, it is respectfully requested that the rejection of claims 1-3 over Japan '495 in view of Fujimoto and Ferguson be withdrawn.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan '495 in view of Ferguson and Fujimoto, and further in view of Kanno.

Claims 4 and 5 are dependent from claim 1 and limited to the features set forth therein. Accordingly, for the same reasons as set forth above with regard to claim 1, claims 4 and 5 are not obvious over the cited references.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan '495 in view of Fujimoto and Ferguson and Kanno and further in view of Alsobrooks et al.

Claim 6 is indirectly dependent from claim 1 and limited to the features set forth therein. Accordingly, for the same reasons as set forth above with regard to claim 1, claim 6 is not obvious over the cited references.

Claims 8 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japan '495 in view of Fujimoto and Ferguson, and further in view of Kazuyoshi.

Claims 8 and 9 are dependent, directly or indirectly, from claim 1 and limited to the features set forth therein. Accordingly, for the same reasons set forth above with regard to claim 1, claims 8 and 9 are not obvious over the cited references.

In view of the amendments to the claims, and the remarks set forth above distinguishing the claimed invention from the cited prior art references, Applicants submit that the Examiner's objections and rejections have been overcome. Accordingly, it is respectfully requested that the objections and rejections be withdrawn and that claims 1-9 be allowed, in addition to claims 10 and 13-17, previously allowed.

CONCLUSION

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

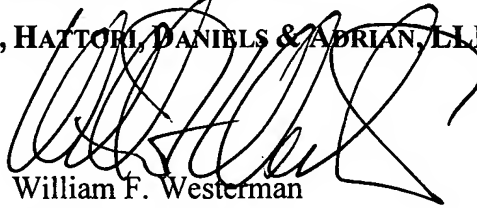
Application No. 10/780,065
Art Unit: 3617

Amendment under 37 C.F.R. §1.111
Attorney Docket No.: 042093

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A large, stylized handwritten signature in black ink, likely belonging to William F. Westerman, is written over the firm name.

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